



## **Federal Circuit: New Invalidity Argument Presented to PTAB for the First Time on Remand from Appeal Is Forfeit**

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In the first appeal, the Federal Circuit vacated an obviousness determination by the PTAB when it found the PTAB applied an incorrect construction of the claim term “grant pending absent state.” The Federal Circuit then adopted the construction proposed by the patent owner in its response, and remanded the case to the PTAB to reconsider obviousness in view of the proper construction.

On remand to the PTAB, the petitioner reasserted its prior position that the prior art combination recited all the limitations of the challenged claims. The petitioner also raised, for the first time, an alternative theory—that if the second prior art combination did not disclose a “grant pending absent state,” it would have been obvious to modify the prior art to include this limitation. The PTAB accepted this alternative theory and again found the challenged claims unpatentable. The patent owner appealed, arguing, among other things, that the petitioner’s alternative theory was untimely for being raised for the first time on remand.

On appeal, the Federal Circuit agreed with the patent owner. According to the Federal Circuit, the particular facts of this case did not present the petitioner with an opportunity to raise its alternative theory on remand. Namely, the alternative theory was responsive to a claim construction position advanced by the patent owner in its response, i.e., before the first appeal. Thus, the petitioner was on notice of the possible claim construction dispute, and should have raised any alternative unpatentability arguments in its reply to the response. Because the petitioner failed to do so at that time, it forfeited the opportunity to raise any such argument on remand.

The Federal Circuit declined to address whether the petitioner was obligated to raise its alternative theory in its petition for *inter partes* review (IPR) for it to be timely raised because that question was not addressed by the PTAB.

**Practice Tip:** This case illustrates the importance of addressing the potential impact of the opposing side's arguments at the first opportunity during an IPR. Failing to do so may result in forfeiture, as it did here.

*Wireless Protocol Innovations, Inc. v. TCT Mobile, Inc.*, 2021-2112 (Fed. Cir. 2022)  
(nonprecedential)

## Categories

Federal Circuit

Patent Trial & Appeal Board

Inter Partes Review

Obviousness

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